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OFFICE OF PETITIONS

In re Application of	:	
Darko Pervan	:	DECISION DISMISSING PETITION
Application No. 10/730,131	:	UNDER 37 CFR 1.183 AND
Filed: December 9, 2003	:	NOTICE OF ABANDONMENT
Attorney Docket No. 033462-037	:	

This is decision on the petition under 37 C.F.R. 1.183, filed February 16, 2006, to waive the requirements of 37 CFR 1.114(a) that the submission be filed with the Request for Continued Examination (RCE).¹

On June 21, 2005, the Office mailed a final Office Action, which set a three-month shortened statutory period to reply. On December 21, 2005, applicants submitted a "Request for Limited Suspension of Action under Rule 103(c), an RCE (without a submission), a request for an extension of time for response within the third month, and paid the requisite fees. On February 16, 2006, applicants filed the present petition and a submission pursuant to 37 CFR 1.114(a).

¹ 37 CFR 1.114 states, in pertinent part:

(a) If prosecution in an application is closed, an applicant may request continued examination of the application by filing a submission and the fee set forth in § 1.17(e) prior to the earliest of:

(1) Payment of the issue fee, unless a petition under § 1.313 is granted;

(2) Abandonment of the application; or

(3) The filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. 141, or the commencement of a civil action under 35 U.S.C. 145 or 146, unless the appeal or civil action is terminated.

Applicant explains:

On December 21, 2005, applicant filed a Request for Continued Examination, together with a Request for a Limited Suspension of Action under 37 CFR § 1.103(c) and the proper fees. At the time of filing, applicant's attorney assumed that the Request for a Limited Suspension of Action under Rule 103(c) qualified as the requisite "submission" of 37 CFR § 1.114. That assumption was based, in part, on the language in 37 CFR § 1.114(c), which states that the "submission" includes, "*but is not limited to*", the documents recited in 37 CFR § 1.114(c).

Applicant's attorney recently became aware of § 709, I, B, 1. (Requirements) of the Manual of Patent Examining Procedure (MPEP), wherein it states that the "request for suspension cannot substitute for the submission". In view of the statement in the MPEP, applicant hereby files a "submission" and petitions the Patent & Trademark Office to retroactively waive the requirement of 37 CFR 1.114(a) that the submission be filed *with* the Request for Continued Examination. It is important to note that in this case, a submission is being filed herewith. Thus, the only requirement that is requested to be waived is the *timing* of the submission.

In essence, applicant requests that the Office permit him to extend the period for filing a response (*i.e.*, the submission) beyond the six-month statutory period set forth in the final Office Action of June 21, 2005. The Office notes that the above-identified application became abandoned on December 22, 2005, for failure to file a timely and proper response within the six-month statutory period for reply.² Abandonment takes place by operation of law for failure to timely submit a proper reply to an Office action.³

In an extraordinary situation, when justice re-quires, any requirement of the regulations in this part **which is not a requirement of the statutes** may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. 37 CFR 1.183.

An applicant may extend the shortened period for reply to a final Office Action within the limits of the statutory six-month period; however, no extension can operate to extend the time beyond the six months. An applicant must file a reply prior to the expiration of the period to avoid abandonment of the application as indicated in 35 U.S.C. § 133.

² See 37 CFR 1.135(a); MPEP 711.02.

³ Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable. 35 U.S.C. § 133.

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